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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/664,364 | 09/18/2000 | Jin-Tae Roh | 3449-0131P | 3941 |

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EXAMINER

PSITOS, ARISTOTELIS M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2653

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DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,364

Applicant(s)

ROH ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 13, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 7, 11, 14-16 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3 and 17 & 18 are rejected under 35 U.S.C. 102(b/e) as anticipated by Osakabe, Spruit et al, or Kim or EP 0557584.

With respect to claim 1, Osakabe discloses a method for recording onto an optical disc wherein optimum power level is determined as noted in the flow charts depicted in figures 9 and 10. Applicants' attention is also drawn to col 1 line 51 to col. 2 line 26. The examiner interprets the limitation of claim 1 line 5 as being met by the additional ability relying upon the erase power as well as the modulation factor as further explained in col 4 starting at line 19.

With respect to Spruit et al, applicants' attention is drawn to col. 1 line 30 to line 62. With respect to the limitations of claim 1 line 5, the examiner interprets the modulation, jitter and error rate as providing the additional second factor.

With respect to Kim, applicants' attention is drawn to tables 1 and 2 and the discussion thereof, wherein the examiner interprets either the speed value or the write strategy as stated in the reference as the second factor.

With respect to the EP document, the detection of the factors in elements 14,15,16 and 17 meet the limitations with respect to line 5 of claim 1.

With respect to the limitations of claims 2 and 3, the examiner interprets the modulation ability in Osakabe, either the modulation factor or jitter in Spruit et al, the speed factor in Kim and the jitter ability in the EP document for the limitations with respect to claim 2, while the limitations of claim 3 are met when the system uses such for the recording of the input data in these systems.

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With respect to claims 17 & 18, this product is met when the above systems operate upon the record medium.

7. Claims 4,5,8,9,10 and 17 & 18 are rejected under 35 U.S.C. 102(b/e) as being anticipated by Osakabe/EP 0557584 or Spruit et al respectively.

With respect to these claims the references are relied upon for the reasons as stated above.

Additionally, with respect to the limitations of claim 10, it is noted that the erasing level in Osakabe or Spruit et al, the edge detector ability in the EP document are interpreted to meet this limitation.

8. Claims 4,5,8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim.

Kim is relied upon for the reasons stated above. Either the write strategy/speed factor or the normalized modulation of the read signal is the second factor.

9. Claims 6 and 13 are rejected under 35 USC 102 (b/e) as being anticipated by either EP 557584 or Spruit et al.

The above documents disclose the additional feature/second test data (factor) as jitter.

Allowable Subject Matter

Claims 7, 11, 14-16, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 13 is allowed over the art of record. None of the cited prior art teach the additional ability of vary the signal format while recording test data onto the test area in this environment as recited by the claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ohara et al is cited as having the optimal recording power along with sensitivities of various discs. Lee et al has the optimum power ability and recording/reproducing system codes, as well as jitter. Miura et al has optimum power values for various zones.

Hard copies of the application files are now separated from this examining corps, hence the examiner can answer no questions that requires a review of the file without sufficient lead-time.

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Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653



AMP